

REMARKS

Claims 1-3, 5-6, 8-11 and 14-18 are pending in this application.

Claims 1, 3, 5, 6, 8-11 and 16-18 have been rejected. No claims have been amended or cancelled.

Claims 1-3, 5-6, 8-11, 14 and 16-18 are rejected under 35 USC § 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Examiner states that the limitation of "curing the topcoat layer at a temperature of 275°C or more" is not described in the specification in such a way as to enable a person skilled in the art to make/or use the invention. The Examiner takes issue that there is no upper limit. The Examiner asserts that there is no way to heat the topcoat layer to a temperature of 1,000,000°C. Under MPEP 706.3 "The primary object of the examination of an application is to determine whether or not the claims are patentable over the prior art. This consideration should not be relegated to a secondary position while undue emphasis is given to nonprior art or "technical" rejections. Effort in examining should be concentrated on truly essential matters, minimizing or eliminating effort on technical rejections which are not really critical. Where a major technical rejection is proper (e.g., lack of proper disclosure, undue breadth, utility, etc.) such rejection should be stated with a full development of the reasons rather than by a mere conclusion coupled with some stereotyped expression...". In the instant application, one skilled in the art could, without undue experimentation, determine the upper limit of the curing temperature, when the topcoat composition no longer cures and decomposes. Applicants did not commit resources to finding the upper limit. Applicants assert that the technical nature of this rejection is not critical and as such is a violation of MPEP 706.3 and request that this rejection be removed.

Claims 1-3, 5-6, 8-11, 14 and 16-18 are rejected under 35 USC § 103(a) as being unpatentable over Applicants' admitted prior art in view of Weber et al (US 5,750,160). The Examiner continues to focus on Claim 19 as originally

filed as an implied admission. However, this implication may be overcome where applicants give another credible reason for drafting the claim in *Jepson* format. In the present application, the preamble describes Applicants own work. Applicants have submitted a 1.132 Declaration by the common inventors of this application and US Patent 7,115,084. US Patent 7,115,084 claims a replaceable fuser member and was filed on the same date as the present application. This declaration states that the preamble of the Jepson claim describes the work of the inventors. Where the preamble of a Jepson claim describes Applicants own work, such may not be used against the claims. *Reading & Bates Construction Co. v. Baker Energy Resources Corp.*, 748 F.2d 645, 650, 223 USPQ 1168, 1172 (Fed. Cir. 1984); *Ehrreich*, 590 F.2d at 909-910, 200 USPQ at 510. Applicants assert that the implication is overcome by this evidence provided. As further evidence that the Jepson preamble is not an implied admission, all of the references cited in the Background of the Invention section of the Application contain Jiann H. Chen and Joseph Pavilsko as common inventors. Once this implied admission is overcome as Applicants believe they have done, the Examiners obviousness rejection fails as there is no teaching of; applying a coating of a primer comprising a silane coupling agent that contains epoxies to the outside of the sleeve; applying a coating of a base cushion elastomer around the outside of the sleeve; curing the base cushion elastomer; machining the coating of the cured base cushion elastomer to a desired thickness; applying a topcoat layer over the machined coating of the base cushion; curing the topcoat layer at a temperature of 275°C or more; and removing the replaceable fuser member from the mandrel.

Claims 1-3, 5-6, 8-11, 14 and 16-18 are rejected under 35 USC § 103(a) as being unpatentable over Applicants' admitted prior art in view of Weber et al/Applicants' admitted prior art in view of Weber et al, further in view of Hartley et al and Chen et al and further in view of Badesha et al (US 5,141,788). As provided above, the primary evidence relied upon by the Examiner is the alleged implied admitted prior art. This is no longer available and the rejection is no longer proper.

Claims 1-3, 5-6, 8-11, 14 and 16-18 are rejected under 35 USC § 103(a) as being unpatentable over Applicants' admitted prior art in view of Weber et al/Applicants' admitted prior art in view of Weber et al, further in view of Hartley et al and Chen et al and further in view of Petropoulos et al (US

5,021,109). As provided above, the primary evidence relied upon by the Examiner is the alleged implied admitted prior art. This is no longer available and the rejection is no longer proper.

Claim 14 is rejected under 35 USC § 103(a) as being unpatentable over Applicants' admitted prior art in view of Weber et al/Applicants' admitted prior art in view of Weber et al, further in view of Hartley et al and Chen et al and further in view of Mikkelsen (US 6,071,110). As provided above, the primary evidence relied upon by the Examiner is the alleged implied admitted prior art. This is no longer available and the rejection is no longer proper.

Claim 18 is rejected under 35 USC § 103(a) as being unpatentable over Applicants' admitted prior art in view of Weber et al further in view of Hartley et al and Chen et al and further in view of Schlueter, Jr., et al (US 5,995,796). As provided above, the primary evidence relied upon by the Examiner is the alleged implied admitted prior art. This is no longer available and the rejection is no longer proper.

In view of the foregoing remarks and amendments, Claims 1-3, 5-6, 8-11 and 14-18 are now deemed allowable and such favorable action is courteously solicited.

Should the Examiner consider that additional amendments are necessary to place the application in condition for allowance, the favor is requested of a telephone call to the undersigned counsel for the purpose of discussing such amendments.

Respectfully submitted,



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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.